

REMARKS

Introduction

Claims 1-20 were originally pending in this application. Claims 1, 7, 9, 10-12 and 16-18 were previously amended. Claims 4 and 13 were cancelled. Claims 19 and 20 were withdrawn from consideration by the Examiner pursuant to 37 CFR 1.142(b). Thus, claims 1 - 3, 5 - 12 and 14 - 18 remain in this application.

Claim Rejections

35 U.S.C. §103(a) – Obviousness

Claims 1-3, 5-12 and 14-18 were rejected under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over Whitehead et al. (US Patent Number 6,422,640) in view of Tolinski (US 2002/0149236). In view of the disclosures of the prior art, applicants cannot agree that the invention defined in claims 1 and 10 would have been obvious over the Whitehead et al. '640 patent in view of the Tolinski '236 application. Accordingly, this rejection is respectfully traversed.

The Prior Art

The Whitehead et al. '640 Patent

The Whitehead et al. '640 patent discloses a door trim panel assembly and method of making the same. Specifically, the '640 patent teaches a door trim panel assembly 10 including a carrier 20 made of plastic material and having a first side 21 and a second side 22. The second side 22 is attached to the inner panel 16 of the door 12. The door trim panel assembly 10 further includes a seal 24 molded as part of the second side 22 of the carrier 20 by the plastic material of

the carrier 20. (Column 3, lines 22-24). Specifically, the seal 24 and the carrier 20 are formed as one piece. Furthermore, the seal 24 surrounds the entire perimeter of the inner panel 16 of the door 12. Importantly, the Whitehead et al. door trim panel assembly 10 includes *a carrier 20 and further includes a finished door trim panel 34* that is attached to the carrier 20 by molding the carrier 20 to the door trim panel, thereby conforming the carrier 20 to the shape of the door trim panel 34. (Column 3, lines 35-55). The Whitehead et al. '640 patent discloses another embodiment including a trim panel 134, a carrier 120 and a seal 124 molded as part of the second side 122 of the carrier 120, but where the seal 124 includes a seal retainer having a groove 138 in which a sealing member 142 is directly applied. The type of trim panel assembly 10 or 110 disclosed by the Whitehead et al. '640 patent consists of a *combination of a separate trim panel presenting a class-A side and a carrier*. Thus, this trim panel assembly is well known in the art and was distinguished from the present invention in the background section of this patent application.

However, the Whitehead et al. '640 patent does not disclose or suggest *a single substrate* that includes both an A-side surface visible from the interior of a vehicle and a B-side surface to which at least one seal is bonded to prevent the entry of moisture between the B-side and the vehicle door, as required by independent claims 1 and 10.

The Tolinski '236 Application

The Tolinski '236 application discloses a vehicle sunroof seal assembly and method of sealing sunroof frame members together. The sunroof seal assembly of the '236 application includes a sunroof frame 20 incorporating a plastic corner piece 24 and an aluminum part 28. The sunroof seal assembly further includes a gasket material 32 that is molded into the corner

piece 24 while still in the mold 90. Importantly, the '236 application teaches that the gasket material 32 is employed to bond the plastic corner piece 24 to the aluminum part 28. Specifically, the plastic corner piece 24, including the gasket material 32, and the aluminum part 28 are placed together, such that the gasket material is sandwiched therebetween, and heated, thereby bonding the corner piece 24 to the aluminum part 28 to form the sunroof frame 20.

Thus, the Tolinski '236 application teaches the use of a gasket material 23, incorporated within a first frame member, as an agent to bond the first frame member to a second frame member during a heating process. The Tolinski '236 application does not disclose or suggest a single substrate that includes both an A-side surface visible from the interior of a vehicle and a B-side surface to which at least one seal is bonded to prevent the entry of moisture between the B-side and the vehicle door, as required by independent claims 1 and 10.

The Present Invention

In contrast to that which is disclosed in the references of record in this case, the present invention as defined in independent claim 1 is directed toward a modular door trim panel assembly including a molded substrate having a first side defining an A-side surface that is visible from the interior of an automotive vehicle and a second side opposite the first side. The second side defines a B-side surface adjacent a vehicle door and includes a pair of side terminal edges and a lower terminal edge extending therebetween. The assembly further includes at least one seal that is co-molded while the substrate is formed and bonded to the B-side of the substrate. The seal extends substantially parallel to the pair of side terminal edges and the lower terminal edge of the substrate and is adapted to prevent the entry of moisture between the B-side of the substrate and the vehicle door. The seal is made of a polymer material suitable for use

within an injection mold that maintains a flexible quality when cured. In addition, the present invention as defined in independent claim 10 is directed toward the modular door trim panel assembly as described above where door frame is also included.

Argument

A rejection based on §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit recently noted, “[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” Ecolochem, Inc. v. Southern Calif. Edison, 56 U.S.P.Q. 2d 1065, 1073 (Fed. Cir. 2000). Here, there is simply no motivation provided in the Whitehead et al. patent or the Tolinski application to combine their teachings. Furthermore, even assuming that such a motivation existed, a combination of these references would not result in the modular door trim panel assembly of the type described in independent claims 1 and 10.

It is respectfully submitted that the Whitehead et al. patent and Tolinski publication skirt around, but do not suggest the claimed invention *as a whole*. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986). Further, it is respectfully submitted that one must pick and choose elements from the structurally dissimilar devices disclosed in the Whitehead et al. patent and Tolinski application and combine these elements by restructuring them, using hindsight and the applicants’ own disclosure, to conclude that the claimed invention is obvious. Applicants respectfully submit that this would be improper in view of the disclosures of the prior art.

The Whitehead et al. ‘640 patent advocates the use of *two separate substrates*: a door trim panel (34)(134) and a carrier (20)(120). The Whitehead et al. ‘640 patent further teaches that the seal (24)(142) is applied to the carrier (20)(120) *after* the panel (34)(134) is formed. On the other hand, the Tolinski ‘236 application teaches the use of bonding *two separate substrates* (24) and (28) with a gasket material (32) molded to one of the substrates (24) when the two substrates (24)(28) are heated together.

The use of the gasket material (32) taught by the Tolinski ‘236 application is entirely contrary to the use of the seal taught by the Whitehead et al. ‘640 patent. Furthermore, the

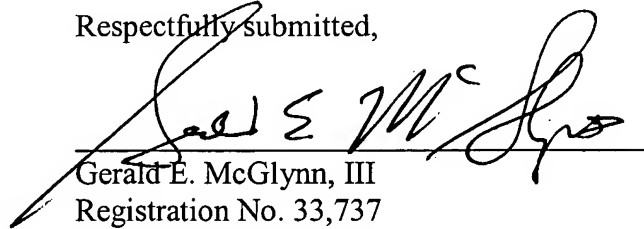
Whitehead et al. '640 patent does not disclose or suggest a door trim panel assembly including a single substrate having an A-side surface and a B-side surface and a seal that is co-molded while the door trim panel is formed and bonded to the B-side surface, where the seal is made of a polymer material suitable for use within an injection mold that maintains a flexible quality when cured. Additionally, the Tolinski '236 application does not disclose or suggest a single substrate that includes both an A-side surface visible from the interior of a vehicle and a B-side surface to which at least one seal is bonded to prevent the entry of moisture between the B-side and the vehicle door. The Whitehead et al. door trim panel assembly and the Tolinski sunroof seal assembly are structurally different from each other and teach away from the present invention. Thus, applicants respectfully submit that the disclosures of each of these references would have to be improperly modified to meet the limitations of independent claims 1 and 10.

In view of the above, it is respectfully submitted that independent claims 1 and 10 recite structure that is not disclosed or suggested by the prior art and is patentably distinguishable from the subject matter of the references discussed above. Claims 2, 3, 5-9 and claims 11, 12 and 14-18 are all ultimately dependent upon independent claims 1 and 10, respectively, and add further perfecting limitations. As such, the other prior art references of record do not make up for the deficiencies of the Whitehead et al. '640 patent and the Tolinski '236 application nor do they suggest the subject invention. However, even if they did, they could only be applied through hindsight after restructuring the disclosure of the prior art in view of applicants' invention. A combination of the prior art in this way to derive applicants' invention would, in and of itself, be an invention.

Conclusion

In view of the above, applicants respectfully submit that the claims clearly distinguish over the prior art and are therefore allowable. Accordingly, applicants respectfully solicit the allowance of the claims pending in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald E. McGlynn, III", is written over a horizontal line.

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